II. REMARKS:

A. Status of the Claims

The application was originally filed with claims 1-4, which are the subject of the current Office Action. All claims are rejected as lacking enablement and claims 1 and 2 are rejected as being anticipated. Claim 1 is amended and claim 5 is added herein. No claims are canceled herein. Support for the amendments and added claim may be found in the specification, particularly at page 7, lines 12-14 and in the examples. Therefore, claims 1-5 are currently pending.

B. The Claims are Enabled

The Action rejects claims 1-4 under § 112, first paragraph as lacking enablement. The Action states that the specification is enabling for a few degenerative conditions of the eye and a few histone deacetylase inhibitors but asserts that it does not provide enablement for all degenerative conditions of the eye and all histone deacetylase inhibitors. Applicants respectfully traverse.

The Action asserts that, according to LANGE Current Medical Diagnostic & treatment, glaucoma and macular degeneration are different disorders, which require different types of treatment. Therefore, the Action reasons that the specification could not enable the claimed invention. However, the specification clearly explains that glaucoma causes continued loss of nerve fiber layer and that, although treating glaucoma by lowering intraocular pressure (IOP) has been shown to be effective in slowing the disease progression

in some patients, some patients continue to lose visual field due to degeneration of the retina and optic nerve. The methods of the present invention seek to address the degeneration in the retina associated with glaucoma in order to improve visual field, or to at least inhibit further loss of visual field (See Spec. page 2, lines 18-27; page 5, lines 20-25), whereas most current therapies for glaucoma seek to lower IOP within the eye. Therefore, the inclusion of glaucoma in the list of acute or chronic degenerative conditions to be treated with the compounds of the present invention is consistent with the objectives of the present invention.

It is well settled patent law that the first paragraph of § 112 requires nothing more than objective enablement. *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). This objective enablement may be provided through broad terminology or illustrative examples. *Id.* The enablement requirement is meant to ensure that the patent discloses sufficient information so that with the patent specification and knowledge in the art, a person with skill in the relevant field can make and use the claimed invention without undue experimentation. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1571 (Fed. Cir. 1991). The skilled artisan is well-versed in the number of ocular conditions that cause degeneration of retinal cells and result in the loss of visual field and would clearly understand the disorders the claimed invention aims to address.

In light of the foregoing arguments, Applicant respectfully requests that the enablement rejection be withdrawn.

C. The Claims are Patentable Over WO 00/08048

Next, the Action rejects claims 1 and 2 as being anticipated by WO 00/08048. According to the Action, the reference teaches the use of a histone deacetylase inhibitor for the treatment of ocular degenerative disorders. Applicants respectfully traverse.

The claimed invention is directed to the treatment of persons suffering from acute or chronic degenerative conditions or diseases of the eye with any one of a number of particular compounds, *i.e.*, SAHA, MS-275, oxamflatin, trichostatin A, depsipeptides, or SBHA. The cited reference, on the other hand is directed to the use of one compound, FR225497, to treat inflammatory disorders, diabetes, diabetic complications, homozygous thalassemia, fibrosis, cirrhosis, acute promyelocytic leukaemia (APL), or protozoal infection. FR225497 is also said to have immunosuppressant and antitumor effect. There is no mention within the reference of the treatment of degenerative diseases of the eye. Nor is there any mention within the reference of the use of SAHA, MS-275, oxamflatin, trichostatin A, depsipeptides or SBHA for the treatment of degenerative diseases of the eye.

For a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show ***all*** features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du*

Pont de Nemours & Co., 224 U.S.P.Q. 409 (Fed. Cir. 1984). Since the cited reference lacks a teaching of the treatment of degenerative diseases of the eye and of the use of the particularly claimed compounds, it can not anticipate the claimed invention.

In light of the foregoing arguments, Applicant respectfully requests that the anticipation rejection based on WO 00/08048 be withdrawn.

D. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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